THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 13

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JAMES T. WEISBURN

Appeal No. 97-0071
Application No. 08/263,033[1]

ON BRIEF

Before CALVERT, LYDDANE, and NASE, Administrative Patent Judges.

NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 through 3, 5 through 11, 13 through 15 and 18 through 21, which are all of the claims pending in this application.

We REVERSE.

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[1] Application for patent filed June 21, 1994.

BACKGROUND

The appellant's invention relates to an insert used in a video display package. Claims 1 and 11 are representative of the subject matter on appeal and a copy of those claims, as they appear in the appellant's brief, is attached to this decision.

The prior art references of record relied upon by the examiner as evidence of obviousness under 35 U.S.C. § 103 are:

Schwennicke	2,531,302	Nov. 21, 1950
Marcheck	2,693,246	Nov. 2, 1954
McGeehins	4,763,790	Aug. 16, 1988
Vartanian	4,972,951	Nov. 27, 1990
Barnhart et al. (Barnhart)	5,140,945	Aug. 25, 1992

Claims 1 through 3, 5, 6, 9 and 10 stand rejected under 35 U.S.C. § 103 as being unpatentable over McGeehins in view of Barnhart.

Claims 1 through 3, 5, 6, 9 and 10 stand rejected under 35 U.S.C. § 103 as being unpatentable over Barnhart in view of McGeehins.

Claims 7 and 8 stand rejected under 35 U.S.C. § 103 as being unpatentable over the references as applied to claims 1 through 3, 5, 6, 9 and 10 above, and further in view of Vartanian.

Claims 11, 13 through 15, 18, 19 and 21 stand rejected under 35 U.S.C. § 103 as being unpatentable over Schwennicke in view of Vartanian and Barnhart.

Claim 20 stands rejected under 35 U.S.C. § 103 as being unpatentable over the references as applied to claims 11, 13 through 15, 18, 19 and 21 above, and further in view of Marcheck.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the § 103 rejections, we make reference to the examiner's answer (Paper No. 10, mailed July 26, 1996) for the examiner's complete reasoning in support of the rejections, and to the appellant's brief (Paper No. 9, filed June 18, 1996) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and

claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. Upon evaluation of all the evidence before us, it is our conclusion that the evidence adduced by the examiner is insufficient to establish a prima facie case of obviousness with respect to claims 1 through 3, 5 through 11, 13 through 15 and 18 through 21. Accordingly, we will not sustain the examiner's rejection of claims 1 through 3, 5 through 11, 13 through 15 and 18 through 21 under 35 U.S.C. § 103. Our reasoning for this determination follows.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie case of obviousness is established by presenting evidence that the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the references before him to make the proposed combination or other modification. See In re Lintner, 9 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972). Furthermore, the conclusion that the claimed subject matter is prima facie obvious must be supported by evidence, as shown by some objective

teaching in the prior art or by knowledge generally available to one of ordinary skill in the art that would have led that individual to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). This the examiner has not done.

We agree with the appellant that the combined teachings of McGeehins and Barnhart would not have suggested placing the hourglass shaped birdfeeding tray 105 of Barnhart in McGeehins' sleeve 10 as set forth in the examiner's rejections of claim 1. We also agree with the appellant that the combined teachings of Schwennicke, Vartanian and Barnhart would not have suggested modifying the frame 1 of Schwennicke's suitcase to be hourglass shaped as set forth in the examiner's rejection of claim 11.

As stated in W. L. Gore & Assoc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984),

> [t]o imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.

It is our conclusion that the only reason to combine the teachings of the applied prior art references in the manner proposed by the examiner results from a review of the appellant's disclosure and the application of impermissible hindsight. Thus, we cannot sustain the examiner's rejections of independent claims 1 and 11, or of claims 2, 3, 5 through 10, 13 through 15 and 18 through 21 dependent thereon[2], under 35 U.S.C. § 103.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1 through 3, 5 through 11, 13 through 15 and 18 through 21 under 35 U.S.C. § 103 is reversed.

[2] We have also reviewed the Vartanian reference additionally applied in the rejection of claims 7 and 8 (dependent on claim 1) and the Marcheck reference applied in the rejection of claim 20 (dependent on claim 11) but find nothing therein which makes up for the deficiencies discussed above regarding claims 1 and 11.

REVERSED

IAN A. CALVERT Administrative Patent Judge	)
WILLIAM E. LYDDANE Administrative Patent Judge	) BOARD OF PATENT) APPEALS) AND) INTERFERENCES
JEFFREY V. NASE Administrative Patent Judge	)

Appeal No. 97-0071
Application No. 08/263,033

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APPENDIX

Claim 1: A facsimile video cassette package including:

an outer flexible sleeve having printed indicia thereon, said sleeve having an open internal cavity with a transverse width, a longitudinal length, and a height; and

an insert positioned within the cavity of the sleeve and substantially conforming in size thereto, said insert being formed by a strip of flexible material having a width substantially equal to the height of the cavity and formed into a frame having a substantially hourglass configuration formed by a pair of spaced end walls and a connecting pair of concavely curved side walls.

Claim 11: A one-piece insert to be used in a video cassette display package for stiffening said package includes a continuous peripheral frame formed of plastic defining a hollow interior and formed in an hourglass configuration, said frame having spaced inclined end walls and concavely curved inclined side walls terminating in spaced peripheral edges, one of said peripheral edges being larger than the other of said edges, with said larger peripheral edge forming a continuous opening communication with the hollow interior to enable a plurality of said frames to be stacked in a nested relationship by inserting the smaller peripheral edge through the opening and into the hollow interior.

APPEAL NO. 97-0071 - JUDGE NASE
APPLICATION NO. 08/263,033

APJ NASE

APJ LYDDANE

APJ CALVERT

DECISION: **REVERSED**

Prepared By: Delores A. Lowe

DRAFT TYPED: 18 Jun 98

FINAL TYPED: